

ESTTA Tracking number: **ESTTA57763**

Filing date: **12/15/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Defendant Motorola, Inc. Motorola, Inc. 1303 East Algonquin Road Schaumburg, IL 60196
Correspondence Address	Thomas M. Williams Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610
Submission	Motion for Summary Judgment
Filer's Name	Elisa Valenzona
Filer's e-mail	evalenzona@usebrinks.com, officeactions@brinkshofer.com
Signature	/emv/
Date	12/15/2005
Attachments	Applicant's Motion for Summary Judgment Exhibit 3 to Exhibit 8 (2 of 4).pdf (63 pages) Applicant's Motion for Summary Judgment Exhibit 3 to Exhibit 8 (2 of 4)_Page_01.tif (1 page)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,)	
)	
Opposer,)	
)	
v.)	Opp. No.: _____
)	App. No.: 78/235,618
)	Pot. Mark: SENSORY MARK
MOTOROLA, INC.,)	(911 Hz tone)
)	
Applicant.)	
)	

BOX - TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

NOTICE OF OPPOSITION

Honorable Commissioner:

NEXTEL COMMUNICATIONS, INC. ("Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, located and doing business at 2001 Edmund Halley Drive, Reston, VA 20191, believing that it will be damaged by registration, hereby opposes Application Serial No. 78/235,618, filed April 9, 2003, under the Trademark Act of 1946, as amended ("Lanham Act"), in the name of MOTOROLA, INC. ("Applicant").

The grounds for opposition are as follows:

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 12 million subscribers to its services nationwide.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer's cellular telephone and dispatch services.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("the 911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows:

"[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON."

8. Applicant's response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as "[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak." The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

9. Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

11. Opposer avers that, as it is a purchaser and potential purchaser of communications devices incorporating two-way radio capabilities from Applicant and other vendors of such devices, and as Opposer also sells such devices to end users, it will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application.

WHEREFORE, Opposer, NEXTEL COMMUNICATIONS, INC., believes and avers that it will be damaged by registration of the 911 Hz tone as aforesaid, and prays that said Application Serial No. 78/235,618 be rejected, that no


registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JOHN I. STEWART, JR., JEFFREY D. SANOK, and MICHAEL H. JACOBS, members of the law firm of CROWELL & MORING LLP, and members of the Bar of the District of Columbia, to prosecute this Opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

John I. Stewart, Jr.
Crowell & Moring LLP
1001 Pennsylvania Avenue, NW
Washington, DC 20004
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

The filing fee in the amount of \$300.00 should be charged to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US). Please credit any overpayments or charge any additional fees to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US).

Respectfully submitted,



John I. Stewart, Jr.
Attorney for Opposer

August 23, 2004

CROWELL & MORING LLP
1001 Pennsylvania Avenue, NW
Washington, DC 20004
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

ESTTA Tracking number: **ESTTA13805**

Filing date: **08/23/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nextel Communications, Inc.
Granted to Date of previous extension	08/22/2004
Address	Nextel Communications, Inc. 2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

Attorney information	John I. Stewart, Jr. Crowell & Moring LLP 1001 Pennsylvania Avenue, NW Washington, DC, DC 20004 UNITED STATES jstewart@crowell.com, kherrmann@crowell.com, wsauers@crowell.com Phone:(202) 624-2500
-----------------------------	---

Applicant Information

Application No	78235618	Publication date	02/24/2004
Opposition Filing Date	08/23/2004	Opposition Period Ends	08/22/2004
Applicant	Motorola, Inc.		

Goods/Services Affected by Opposition

Class 009. First Use: 19910506 First Use In Commerce: 19910506
All goods and services in the class are opposed, namely: Two-way radios

Attachments	Notice of Opposition (Executed).pdf (4 pages)
Signature	/John I. Stewart, Jr./
Name	John I. Stewart, Jr.
Date	08/23/2004

EXHIBIT 4

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 4 in Support of Applicant's Motion for Summary Judgment

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,)	
)	
Opposer,)	
)	Opp. No.: 91/161,817
v.)	App. No.: 78/235,618
)	Pot. Mark: SENSORY MARK
MOTOROLA, INC.,)	(911 Hz tone)
)	
Applicant.)	
)	

OPPOSER'S RESPONSE TO APPLICANT'S
FIRST SET OF INTERROGATORIES

Pursuant to Federal Rules of Civil Procedure 33, Opposer, Nextel Communications, Inc. (“**Opposer**”) responds to Applicant Motorola, Inc.’s (“**Applicant**”) First Set of Interrogatories [Nos. 1-10].

GENERAL OBJECTIONS

1. Opposer objects to the interrogatories to the extent that they request information that is covered by the attorney-client privilege and/or work product doctrine or any other applicable privilege. Any responsive documents will be reflected on a privilege log at the appropriate time.

2. Opposer objects to each interrogatory that purports to impose upon Opposer any obligation greater than or different from those required under the Federal Rules of Civil Procedure, the rules of the Trademark Trial and Appeal Board, or applicable case law.

3. Opposer objects to the interrogatories to the extent that they seek confidential, proprietary, or commercially sensitive information. To the extent that such information is otherwise discoverable, Opposer will provide it to Applicant pursuant to terms of a suitable Protective Order entered by the TTAB.

4. The following responses reflect Opposer's present knowledge, information, and belief, and may be subject to change or modification based on Opposer's further discovery, or on facts or circumstances that may come to Opposer's knowledge.

5. Opposer objects to the interrogatories to the extent that they request identification of documents. Where appropriate, Opposer will produce non-privileged documents pursuant to Fed. R. Civ. P. 33(d) instead of undertaking the burden of identifying the documents. A response stating that Opposer will produce/provide documents, things or information is not a representation that any responsive document, thing or information necessarily exists. To the extent Opposer states that it will produce/provide responsive documents, things, or information, it will produce/provide such documents, things, or information as they exist and can be located after a reasonable search of documents, things, and information within Opposer's possession, custody and control.

6. In addition to all facts, information and documents identified or referred to in these responses, Opposer reserves its right to use and rely upon any facts, information or documents provided by Applicant during discovery.

7. These General Objections shall apply to each of Opposer's responses. To the extent that specific objections are provided because they are believed to be particularly

applicable to specific interrogatories, they are not to be construed as a waiver of any General Objection applicable to the information falling within the scope of the interrogatory.

Subject to these General Objections and the specific objections hereinafter set forth, Opposer responds to Applicant's First Set of Interrogatories as follows:

1. Describe in detail all facts relating to Opposer's contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (§ 9 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections, Opposer objects to this interrogatory to the extent it seeks to invade the attorney-client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios.

2. Describe in detail all facts relating to Opposer's contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to this interrogatory as it invades the attorney client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the phrase "inherently distinctive" calls for a legal conclusion.

3. Describe in detail all facts relating to Opposer's contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (§ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: Opposer incorporates its response to Interrogatory No. 1 as if fully set forth herein. Opposer further objects that the phrase "acquired distinctiveness" calls for a legal conclusion.

4. Identify and describe the types of individuals and the classes of consumers or entities who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the use of the phrase "or any mark similar thereto" is vague, ambiguous and calls for a legal conclusion. Opposer further objects that this interrogatory is overbroad, unduly burdensome and not reasonable calculated to lead to the discovery of admissible evidence.

5. If Opposer has ever received an opinion, from legal counsel or otherwise, relating to Applicant's Mark, including but not limited to any opinion on whether Applicant has used the Mark, whether the Mark is inherently distinctive, or whether the Mark has acquired distinctiveness, for each such opinion: describe the opinion in detail, including but not limited to the date of the opinion, the author(s) of the opinion, the recipient(s) of the opinion, and the substance of the opinion; identify each document or thing that relates to or constitutes the opinion; and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce.

Opposer further objects to this interrogatory in that it seeks to invade the attorney-client and/or attorney work product privilege.

6. Describe how and to whom Opposer's two-way radios are marketed, promoted, sold, and distributed, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to this interrogatory in that it is vague, overbroad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence, to the extent that it calls for information relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application.

7. Describe in details the facts and circumstances surrounding Opposer's first knowledge of Applicant's Mark, Applicant's use of the Mark, and of Application No. 78/235,618, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to this interrogatory to the extent it seeks to invade the attorney-client privilege and/or attorney work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it first learned that Applicant was claiming it had trademark rights in the 911 Hz tone that emits from Applicant's two-way radios when it became aware of Opposer's trademark application.

8. Describe in detail the facts and circumstances surrounding any instance in which a person has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios, and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to the use of the term "confused" in that it is vague, ambiguous and calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that it is not aware of any instances of confusion as to the source of Applicant's two-way radios or any service provided by Applicant in connection with such radios.

9. Identify each witness (whether fact or expert) whom Opposer intends to call during the testimony period of this proceeding and for each witness, describe in detail the subject matter of his/her testimony, describe in detail the facts upon which his/her testimony will be based, identify the documents and things upon which his/her testimony will be based, and provide a detailed written description of any opinions the witness may offer in his/her testimony.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to this interrogatory as premature. Subject to and without waiving its objections, Opposer states that it will disclose anticipated fact and expert witnesses in accordance with applicable Pretrial Orders, the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Practice and Procedure rules.


10. Describe in detail all facts relating to Opposer's contention that it will be damaged if Applicant's Mark is registered (§ 11 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

RESPONSE: In addition to the General Objections set forth above, Opposer objects to this interrogatory in that it invades the attorney client privilege and/or work product doctrine. Opposer further objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as

trademark use in commerce. Subject to and without waiving its objections, Opposer states that it sells wireless phones and devices that incorporate electronic tones, that Opposer and Applicant are business partners and that Applicant manufactures wireless phones and devices for Opposer and Opposer's competitors.

Respectfully submitted,

April 25, 2005




John T. Stewart, Jr.
Attorney for Opposer

CROWELL & MORING LLP
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the OPPOSER'S RESPONSE TO APPLICANT'S FIRST SET OF INTERROGATORIES was served on counsel for the Applicant, this 25th day of April, 2005, by sending same via electronic mail and First Class Mail, postage prepaid, to:

John T. Gabrielides
BRINKS, HOFER, GILSON & LIONE
455 North Cityfront Plaza Drive
NBC Tower, Suite 3600
Chicago, Illinois 60611-5599



2229060

EXHIBIT 5

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 5 in Support of Applicant's Motion for Summary Judgment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,)	
)	
Opposer,)	
)	
v.)	
)	
MOTOROLA, INC.,)	
)	
Applicant.)	
)	

Opp. No.: 91/161,817
App. No.: 78/235,618
Pot. Mark: SENSORY MARK
(911 Hz tone)

**OPPOSER'S RESPONSE TO APPLICANT'S FIRST SET OF
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

Opposer responds to Applicant's First Set of Requests for Production of Documents and Things as follows:

GENERAL OBJECTIONS

The "General Objections" set forth in Opposer's Response to Applicant's First Set of Interrogatories are incorporated herein by reference.

REQUESTS

1. All documents that refer or relate to Opposer's first knowledge of Applicant's Mark.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

2. All documents that refer or relate to Opposer's first knowledge of Applicant's use of Applicant's Mark in connection with two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

3. All documents that refer or relate to Opposer's first knowledge of Application No. 78/235,618.

RESPONSE: Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

4. All documents that refer or relate to Application No. 78/235,618.

RESPONSE: Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

5. All documents that refer or relate to Applicant's Mark.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

6. All documents that refer or relate to Applicant's use of Applicant's Mark in connection with two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

7. All documents that refer or relate to Applicant's alleged non-use of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 9 of Opposer's Notice of Opposition.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it will produce all non-privileged documents and things responsive to this Request.

8. All documents that refer or relate to the inherent distinctiveness of Applicant's Mark in connection with two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "inherent distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

9. All documents that refer or relate to the alleged lack of inherent distinctiveness of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 10 of Opposer's Notice of Opposition.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "inherent distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

10. All documents that refer or relate to the acquired distinctiveness of Applicant's Mark in connection with two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "acquired distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

11. All documents that refer or relate to the alleged lack of acquired distinctiveness of Applicant's Mark in connection with two-way radios, as referred to in, for example, ¶ 10 of Opposer's Notice of Opposition.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects to the use of the phrase "acquired distinctiveness" in that it calls for a legal conclusion. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

12. All documents that refer or relate to the damage that Opposer will allegedly suffer if Applicant's Mark is registered, as referred to in, for example, ¶ 11 of Opposer's Notice of Opposition.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that it will produce all non-privileged documents and things responsive to this Request.

13. All documents that refer or relate to the types of individuals or entities, or the classes of consumers or entities, who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the Request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects that the use of the phrase "or any mark similar thereto" is vague, ambiguous and calls for a legal conclusion.

14. Documents sufficient to show Opposer's yearly sales volume (in units, dollars, and number of purchasers) of two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in

Applicant's application and that there are no non-privileged documents responsive to this Request.

15. Documents sufficient to show each entity from whom Opposer purchases or has purchased two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application and that there are no non-privileged documents responsive to this Request.

16. A sample of each advertisement or promotional item that includes Applicant's Mark, including any such advertisements or promotional items that are used by, on behalf of, or for the benefit of Opposer.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

17. All documents that refer or relate to Opposer's decision to use Applicant's Mark in Opposer's advertisements or promotional items.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

18. All documents that relate to the development or drafting of advertisements or promotional items that use Applicant's Mark, whether the advertisement or promotional item was ever distributed, displayed, or used.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

19. Documents sufficient to show the yearly amount spent for each advertisement or promotional item identified in response to Document Request No. 16.

RESPONSE: Opposer incorporates its response to Request No. 16 as if fully set forth herein.

20. All documents that refer or relate to any trademark search conducted by or on behalf of Opposer for or in connection with Applicant's Mark.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer will produce all non-privileged documents and things responsive to this Request.

21. All documents that refer or relate to any survey, poll, research, or investigation made, conducted by, on behalf of, or for the benefit of Opposer that refers or relates to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.

RESPONSE: In addition to the General Objections, Opposer objects to the use of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

22. All documents that refer or relate to any instance in which an individual has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

RESPONSE: In addition to the General Objections, Opposer objects to the term "confused" in that it is vague, ambiguous and calls for a legal conclusions. Subject to and without waiving its objections, Opposer states that there are no non-privileged documents responsive to this Request.

23. All documents that refer or relate to the manner in which Opposer markets, promotes, sells, or distributes two-way radios.

RESPONSE: In addition to the General Objections, Opposer objects to this Request in that it is vague, overbroad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it calls for production of all documents relating to Opposer's different products and services marketed, promoted, sold and distributed under various marks. Subject to and without waiving its objections, Opposer states that it does not market, promote, sell or distribute two-way radios that emit the 911 Hz tone as claimed in Applicant's application and that there are no non-privileged documents responsive to this Request.

24. All documents that describe Opposer's policies and procedures regarding the destruction or retention of documents.

RESPONSE: In addition to the General Objections, Opposer objects that this Request is overbroad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving these objections, Opposer states that, beginning July 15, 2002, Opposer adopted the following policy:

"[S]torage of email will be limited to 90 days. Data older than 90 days will automatically be deleted from the email servers. This applies to data in the Inbox, Sent Items, Deleted Items, and the Calendar. Users may save their own email, calendars, etc. to their local computers for longer than that period if they choose."

25. All documents that Opposer intends to rely upon in this proceeding.

RESPONSE: Subject to and without waiving the General Objections, Opposer states that it intends to rely on all non-privileged documents produced herewith or in any supplement hereto and reserves its right to rely on any documents produced by Applicant.

26. All documents identified by Opposer in its answers to Applicant's First Set of Interrogatories.

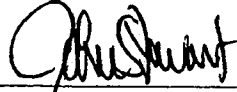
RESPONSE: Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

27. All documents referred to by Opposer in answering Applicant's First Set of Interrogatories.

RESPONSE: Subject to and without waiving the General Objections, Opposer will produce all non-privileged documents and things responsive to this Request.

April 25, 2005

Respectfully submitted,



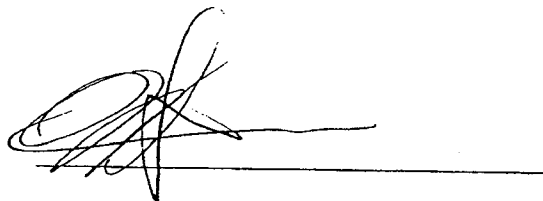
John I. Stewart, Jr.
Attorney for Opposer

CROWELL & MORING LLP
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the OPPOSER'S RESPONSE TO APPLICANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS was served on counsel for the Applicant, this 25th day of April, 2004, by sending same via electronic mail and First Class Mail, postage prepaid, to:

John T. Gabrielides
BRINKS, HOFER, GILSON & LIONE
455 North Cityfront Plaza Drive
NBC Tower, Suite 3600
Chicago, Illinois 60611-5599

A handwritten signature in black ink, appearing to be 'John T. Gabrielides', is written over a horizontal line.

2229102

EXHIBIT 6

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 6 in Support of Applicant's Motion for Summary Judgment

Feb 4, 2004

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
www.uspto.gov

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|--------------------------------------|-------------------------------------|
| 1. Serial No.:
78/235,618 | 2. Mark:
No Drawing-Sensory Mark |
| 3. International Class(es):
9 | |
| 4. Publication Date:
Feb 24, 2004 | 5. Applicant:
Motorola, Inc. |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202)512-1800

By direction of the Commissioner.

☐ AMENDMENT STAGE

☒ NO CHANGE

☒ PUBLICATION/REGISTRATION STAGE

Name TRACY SMITH L.O. 112 Date 01/05/2004 Serial No. 7 /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)

	Amended	Data Element
Class Data	<input type="checkbox"/>	Prime/International Class
	<input type="checkbox"/>	Goods and Services
	<input type="checkbox"/>	First Use Date
	<input type="checkbox"/>	First Use in Commerce Date
Mark Data	<input type="checkbox"/>	In Another Form
	<input type="checkbox"/>	Certification
	<input type="checkbox"/>	1b
	<input type="checkbox"/>	Word Mark
Misc. Mark Data	<input type="checkbox"/>	Pseudo Mark
	<input type="checkbox"/>	Mark Drawing Code
	<input type="checkbox"/>	Design Search Code
	<input type="checkbox"/>	Scan Sub Drawing
Section 2(f)	<input type="checkbox"/>	Mark Description
	<input type="checkbox"/>	Disclaimer
	<input type="checkbox"/>	Lining/Stippling
	<input type="checkbox"/>	Name/Portrait/Consent
Foreign Reg. Data	<input type="checkbox"/>	Translation
	<input type="checkbox"/>	Section 2(f) Entire Mark
	<input type="checkbox"/>	Section 2(f) Limitation Statement
	<input type="checkbox"/>	Section 2(f) in Part
Owner Data	<input type="checkbox"/>	Amended Register
	<input type="checkbox"/>	Amended Register Date
	<input type="checkbox"/>	Foreign Country
	<input type="checkbox"/>	44(d)
Amd/Corr Restr.	<input type="checkbox"/>	Foreign Application Number
	<input type="checkbox"/>	Foreign Application Filing Date
	<input type="checkbox"/>	Foreign Registration Number
	<input type="checkbox"/>	Foreign Registration Date
Prior U.S. Reg.	<input type="checkbox"/>	Foreign Registration Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Number
	<input type="checkbox"/>	Foreign Reg. Renewal Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Date
Correspondence	<input type="checkbox"/>	Owner Name
	<input type="checkbox"/>	DBA/AKA/TA
	<input type="checkbox"/>	Address 1
	<input type="checkbox"/>	Address 2
Other:	<input type="checkbox"/>	City
	<input type="checkbox"/>	State
	<input type="checkbox"/>	Zip Code
	<input type="checkbox"/>	Citizenship
Correspondence	<input type="checkbox"/>	Entity
	<input type="checkbox"/>	Entity Statement
	<input type="checkbox"/>	Composed of
	<input type="checkbox"/>	Assignment(s)/Name Change
Correspondence	<input type="checkbox"/>	Concurrent Use
	<input type="checkbox"/>	Prior Registration
	<input type="checkbox"/>	Attorney
	<input type="checkbox"/>	Domestic Representative
Correspondence	<input type="checkbox"/>	Attorney Docket Number
	<input type="checkbox"/>	Correspondence Firm Name/Address

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE TRACY SMITH

Other: _____

TRADEMARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE

☐ NO CHANGE

☐ PUBLICATION/REGISTRATION STAGE

Name: TRACY SMITH L.O. 112 Date 11/18/2003 Serial No. 7 /

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)

	Amended	Data Element
Class Data	<input type="checkbox"/>	Prime/International Class
	<input type="checkbox"/>	Goods and Services
	<input type="checkbox"/>	First Use Date
	<input type="checkbox"/>	First Use in Commerce Date
Mark Data	<input type="checkbox"/>	In Another Form
	<input type="checkbox"/>	Certification
	<input type="checkbox"/>	1b
	<input checked="" type="checkbox"/>	Word Mark
Misc. Mark Data	<input type="checkbox"/>	Pseudo Mark
	<input type="checkbox"/>	Mark Drawing Code
	<input type="checkbox"/>	Design Search Code
	<input type="checkbox"/>	Scan Sub Drawing
Section 2(f)	<input checked="" type="checkbox"/>	Mark Description
	<input type="checkbox"/>	Disclaimer
	<input type="checkbox"/>	Lining/Stippling
	<input type="checkbox"/>	Name/Portrait/Consent
Foreign Reg. Data	<input type="checkbox"/>	Translation
	<input type="checkbox"/>	Section 2(f) Entire Mark
	<input type="checkbox"/>	Section 2(f) Limitation Statement
	<input type="checkbox"/>	Section 2(f) in Part
Owner Data	<input type="checkbox"/>	Amended Register
	<input type="checkbox"/>	Amended Register Date
	<input type="checkbox"/>	Foreign Country
	<input type="checkbox"/>	44(d)
Amd/Corr Restr.	<input type="checkbox"/>	Foreign Application Number
	<input type="checkbox"/>	Foreign Application Filing Date
	<input type="checkbox"/>	Foreign Registration Number
	<input type="checkbox"/>	Foreign Registration Date
Prior U.S. Reg.	<input type="checkbox"/>	Foreign Registration Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Number
	<input type="checkbox"/>	Foreign Reg. Renewal Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Date
Correspondence	<input type="checkbox"/>	Owner Name
	<input type="checkbox"/>	DBA/AKA/TA
	<input type="checkbox"/>	Address 1
	<input type="checkbox"/>	Address 2
Other	<input type="checkbox"/>	City
	<input type="checkbox"/>	State
	<input type="checkbox"/>	Zip Code
	<input type="checkbox"/>	Citizenship
LIE	<input type="checkbox"/>	Entity
	<input type="checkbox"/>	Entity Statement
	<input type="checkbox"/>	Composed of
	<input type="checkbox"/>	Assignment(s)/Name Change
DATE	<input type="checkbox"/>	Concurrent Use
	<input type="checkbox"/>	Prior Registration
	<input type="checkbox"/>	Attorney
	<input type="checkbox"/>	Domestic Representative
Other	<input type="checkbox"/>	Attorney Docket Number
	<input type="checkbox"/>	Correspondence Firm Name/Address
	<input type="checkbox"/>	
	<input type="checkbox"/>	

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE Other: Cofm 10/17/03 DATE 11/18/2003 TRACY SMITH

NOV 20 2003

Nextel - 0010003
Opp. No. 91/161,817

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: (Design Mark Only)

Serial No: 78235618



Mail Date: 10202003



Doc. Type: Responses to Office Actions



No Fee

RAM Mail Date: 102003



RECEIVED
2003 NOV - 7 A 10:33
TMO
LAW OFFICE 112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc. Examining Attorney: Patricia Malesardi Evanko

Serial No: 78235618 Law Office: 112

Filed: April 22, 2003 Int'l Class: 009

Mark: (SENSORY MARK ONLY)

Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU

NO FEE

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3514

RECEIVED

2003 NOV -1 A 10:33

TMEO
LAW OFFICE 112

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

CERTIFICATE OF MAILING BY FIRST CLASS MAIL	
I, <u>Kristen D. Poggensee</u>	hereby certify that this correspondence is
(printed name)	
being deposited with the United States Postal Service on <u>10/17/03</u>	as first
(date)	
class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

Responsive to the Office Action dated October 17, 2003, Applicant submits the following description of the mark:

The mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.

Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.



10-20-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #64

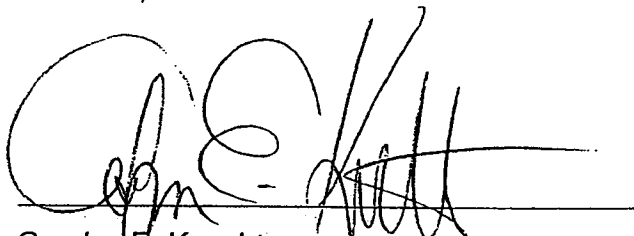
Nextel - 0010005
Opp. No. 91/161,817

The specimen being submitted was in use in commerce at least as early as the filing date of the application.

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Motorola, Inc.

A handwritten signature in black ink, appearing to read 'Carolyn E. Knecht', written over a horizontal line.

Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc. Examining Attorney: Patricia Malesardi Evanko
Serial No.: 78235618 Law Office: 112
Filed: April 22, 2003 Int'l Class: 009
Mark: (SENSORY MARK ONLY)
Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

CERTIFICATE OF MAILING BY FIRST CLASS MAIL	
I, <u>Kristen D. Poggensee</u>	hereby certify that this correspondence is
(printed name)	
being deposited with the United States Postal Service on <u>10/17/03</u>	as first
(date)	
class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

Responsive to the Office Action dated October 17, 2003, Applicant submits the following description of the mark:

The mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.

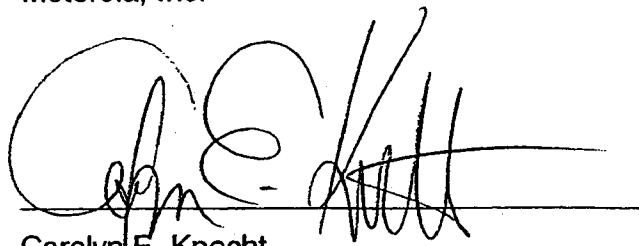
Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.

The specimen being submitted was in use in commerce at least as early as the filing date of the application.

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Motorola, Inc.

A handwritten signature in black ink, appearing to read 'Carolyn E. Knecht', is written over a horizontal line.

Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Motorola, Inc. Examining Attorney: Patricia Malesardi Evanko
Serial No: 78235618 Law Office: 112
Filed: April 22, 2003 Int'l Class: 009
Mark: (SENSORY MARK ONLY)
Attorney Docket No: TM03-1006

October 17, 2003

BOX ITU
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

RESPONSE TO OFFICE ACTION DATED OCTOBER 17, 2003 WITH DECLARATION

CERTIFICATE OF MAILING BY FIRST CLASS MAIL	
I, <u>Kristen D. Poggensee</u>	hereby certify that this correspondence is
(printed name)	
being deposited with the United States Postal Service on <u>10/17/03</u>	as first
(date)	
class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:	
Date: <u>10/17/03</u>	Signature: <u>Kristen D. Poggensee</u>

Responsive to the Office Action dated October 17, 2003, Applicant submits the following description of the mark:

The mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.

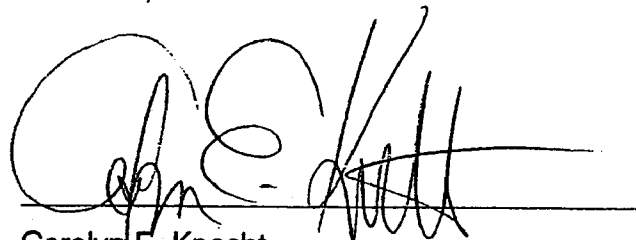
Applicant submits a CD specimen for the above-referenced sound mark. TMEP §904, §1202.15. The specimen is a sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.

The specimen being submitted was in use in commerce at least as early as the filing date of the application.

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Motorola, Inc.

A large, stylized handwritten signature in black ink, appearing to read 'Carolyn E. Knecht', written over a horizontal line.

Carolyn E. Knecht

Senior Trademark Counsel

Date: Oct. 17, 2003

1

To: Motorola, Inc. (carrie.knecht@motorola.com)
Subject: TRADEMARK APPLICATION NO. 782-1513 TM03-1006
Sent: 10/17/03 9:43:04 AM
Sent As: ECom112
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/235618

APPLICANT: Motorola, Inc.

CORRESPONDENT ADDRESS:

Carolyn E. Knecht
Motorola, Inc.
600 North U.S. Highway 45
Libertyville IL USA 60196

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom112@uspto.gov

MARK:

CORRESPONDENT'S REFERENCE/DOCKET NO: TM03-1006

CORRESPONDENT EMAIL ADDRESS:

carrie.knecht@motorola.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 78/235618

The assigned examining attorney has reviewed the referenced application and determined the following.

Search Results

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Nextel - 0010011
Opp. No. 91/161,817

Description of the Mark Needed

The applicant must submit a concise description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The description must identify the sound mark in common English terms. For example, the following form is acceptable, if accurate:

The mark consists of the sound of [specify, e.g., a ringing telephone].

Specimen Required

An application based on use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), must include a specimen showing use of the mark in commerce on or in connection with the goods/services. TMEP §904. The application does not contain a specimen. Because this application is for a sound mark, the specimen must be a sound file. TMEP Section 1212.05. The applicant must submit a specimen, and must submit the following statement:

The specimen was in use in commerce at least as early as the filing date of the application.

This statement must be verified with an affidavit or a declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.09.

A sample declaration is set forth below for the applicant's convenience.

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of your response, please insert the declaration signed by someone authorized to sign under 37 C.F.R. §2.33(a):

The specimen was in use in commerce at least as early as the filing date of the application.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature _____

Name and Position _____

Date _____

NOTE: For the signature above, use the same format as the electronic signature on the original e-TEAS application, e.g., /john doe/ or /jd/. 37 CFR §2.193(c)(1)(iii); TMEP §§304.08 and 804.05.

/Patty Evanko/
Trademark Examining Attorney
Law Office 112
(703)308-9112, ext. 163
patty.evanko@uspto.gov (questions only)

How to respond to this Office Action:

Nextel - 0010013
Opp. No. 91/161,817

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

DOCUMENT INFORMATION	
TRADEMARK/SERVICEMARK APPLICATION	
VERSION 1.24	
APPLICANT INFORMATION	
NAME	Motorola, Inc.
STREET	1303 East Algonquin Road
CITY	Schaumburg
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60196
TELEPHONE NUMBER	847-523-1633
FAX NUMBER	847-523-4348
APPLICANT ENTITY INFORMATION	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Delaware
TRADEMARK/SERVICEMARK INFORMATION	
MARK	NO DRAWING (SOUND MARK)
TYPED FORM	Yes
BASIS FOR FILING AND GOODS/SERVICES INFORMATION	
USE IN COMMERCE: SECTION 1(a)	Yes
SPECIMEN	Yes
SPECIMEN DESCRIPTION	A sound specimen for this application has been submitted separately to the TEAS Help Section.

78235618

INTERNATIONAL CLASS NUMBER	009
LISTING OF GOODS AND/OR SERVICES	Two-way radios
FIRST USE ANYWHERE DATE	05/06/1991
FIRST USE IN COMMERCE DATE	05/06/1991
OPTIONAL INFORMATION	
DESCRIPTION OF THE MARK	The mark consists of a tone at 911 Hz played at a cadence of 25ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON..
ATTORNEY INFORMATION	
NAME	Carolyn E. Knecht
STREET	600 North U.S. Highway 45
CITY	Libertyville
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60196
FIRM NAME	Motorola, Inc.
E-MAIL ADDRESS	carrie.knecht@motorola.com
AUTHORIZE E-MAIL COMMUNICATION	Yes
TELEPHONE NUMBER	847-523-5876
FAX NUMBER	847-523-4348
ATTORNEY DOCKET NUMBER	TM03-1006
OTHER APPOINTED	Arch M. Ahern

78235618

ATTORNEY(S)	
FEE INFORMATION	
TOTAL FEES PAID	335
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1
LAW OFFICE INFORMATION	
E-MAIL ADDRESS FOR CORRESPONDENCE	carrie.knecht@motorola.com
SIGNATURE AND OTHER INFORMATION	
SIGNATURE	/cek/
DATE	04/09/2003
NAME	Carolyn E. Knecht
TITLE	Senior Trademark Counsel
MAILING ADDRESS	
LINE	Carolyn E. Knecht
LINE	Motorola, Inc.
LINE	600 North U.S. Highway 45
LINE	Libertyville IL USA 60196
SERIAL NUMBER INFORMATION	
SERIAL NUMBER	78235618
RAM INFORMATION	
RAM SALE NUMBER	828
RAM ACCOUNTING DATE	04/09/2003

78235618

INTERNET TRANSMISSION DATE	Wed Apr 09 13:04:09 EDT 2003
TEAS STAMP	USPTO/BAS-1361822222-20030409130409526135-78235618- 200551f906c6de47dcd8f64dcaa871f0ad-DA-828-20030409130129232154
E-MAIL ADDRESS FOR ACKNOWLEDGMENT	kristen.poggensee@motorola.com

<SERIAL NUMBER> 78235618

<FILING DATE> 04/09/2003

<DOCUMENT INFORMATION>

<TRADEMARK/SERVICEMARK APPLICATION>

<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME> Motorola, Inc.
<STREET> 1303 East Algonquin Road
<CITY> Schaumburg
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60196
<TELEPHONE NUMBER> 847-523-1633
<FAX NUMBER> 847-523-4348

<APPLICANT ENTITY INFORMATION>

<CORPORATION: STATE/COUNTRY OF INCORPORATION> Delaware

<TRADEMARK/SERVICEMARK INFORMATION>

<MARK> NO DRAWING (SOUND MARK)

<TYPED FORM> Yes

~Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended).~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>

<USE IN COMMERCE: SECTION 1(a)> Yes

~The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, or the applicant's predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.~

Applicant attaches one SPECIMEN for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services.

<SPECIMEN> Yes

<SPECIMEN DESCRIPTION> A sound specimen for this application has been submitted separately to the TEAS Help Section.

<INTERNATIONAL CLASS NUMBER> 009

<LISTING OF GOODS AND/OR SERVICES> Two-way radios

<FIRST USE ANYWHERE DATE> 05/06/1991
<FIRST USE IN COMMERCE DATE> 05/06/1991

<OPTIONAL INFORMATION>

<DESCRIPTION OF THE MARK> The mark consists of a tone at 911 Hz played at a cadence of 25ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON..

<ATTORNEY INFORMATION>

<NAME> Carolyn E. Knecht
<STREET> 600 North U.S. Highway 45
<CITY> Libertyville
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60196
<FIRM NAME> Motorola, Inc.
<E-MAIL ADDRESS> carrie.knecht@motorola.com
<AUTHORIZE E-MAIL COMMUNICATION> Yes
<TELEPHONE NUMBER> 847-523-5876
<FAX NUMBER> 847-523-4348
<ATTORNEY DOCKET NUMBER> TM03-1006
<OTHER APPOINTED ATTORNEY(S)> Arch M. Ahern

<FEE INFORMATION>

<TOTAL FEES PAID> 335
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>

~The USPTO is authorized to communicate with the applicant's attorney at the below e-mail address~

<E-MAIL ADDRESS FOR CORRESPONDENCE> carrie.knecht@motorola.com

<SIGNATURE AND OTHER INFORMATION>

~The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in

78235618

commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.~

<SIGNATURE>

/cek/

<DATE>

04/09/2003

<NAME>

Carolyn E. Knecht

<TITLE>

Senior Trademark Counsel

<MAILING ADDRESS>

<LINE> Carolyn E. Knecht

<LINE> Motorola, Inc.

<LINE> 600 North U.S. Highway 45

<LINE> Libertyville IL USA 60196

<SERIAL NUMBER INFORMATION>

<SERIAL NUMBER> 78235618

<RAM INFORMATION>

<RAM SALE NUMBER> 828

<RAM ACCOUNTING DATE> 04/09/2003

<INTERNET TRANSMISSION DATE> Wed Apr 09 13:04:09 EDT 2003

<TEAS STAMP>

USPTO/BAS-136182222-20030409130409526135-78235618-

200551f906c6de47dcd8f64dcaa871f0ad-DA-828-20030409130129232154

E-MAIL ADDRESS FOR ACKNOWLEDGMENT> kristen.poggensee@motorola.com

Internet Transmission Date:
2003/04/09

Serial Number:
78235618

Filing Date:
2003/04/09



TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: \$335

RAM SALE NUMBER: 828
RAM ACCOUNTING DATE: 04/09/2003

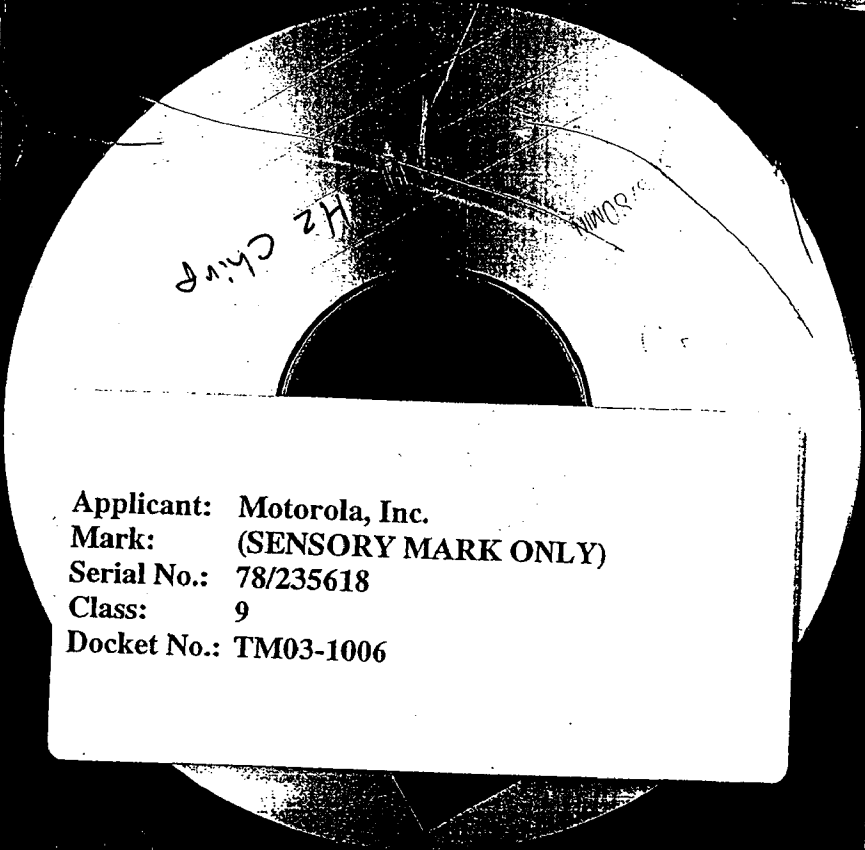


NO OCR



04-09-2003

Nextel - 0010022
Opp. No. 91/161,817



Applicant: Motorola, Inc.
Mark: (SENSORY MARK ONLY)
Serial No.: 78/235618
Class: 9
Docket No.: TM03-1006

Drawing Page

Serial Number:

78235618

Applicant:

Motorola, Inc.
1303 East Algonquin Road
Schaumburg IL USA 60196



Date of First Use:

05/06/1991

Date of First Use in Commerce:

05/06/1991

Goods and Services:

Two-way radios

Mark:

NO DRAWING (SOUND MARK)

PUBLISHED

2/24//04

Nextel - 0010024
Opp. No. 91/161,817

Drawing Page

Serial Number:

78235618

Applicant:

Motorola, Inc.
1303 East Algonquin Road
Schaumburg IL USA 60196



Date of First Use:

05/06/1991

Date of First Use in Commerce:

05/06/1991

Goods and Services:

Two-way radios

Mark:

NO DRAWING (SOUND MARK)

PUBLISHED
2/24//04



NO OCR



04-09-2003

Nextel - 0010025
Opp. No. 91/161,817

EXHIBIT 7

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 7 in Support of Applicant's Motion for Summary Judgment

Exhibit 7 is being Express Mailed directly to Ms. Goodman's attention at the TTAB.

Exhibit 7 consists of a .wav file that could not be electronically filed. Exhibit 7 is a CD that contains an audio file for Nextel's 911 Hz Chirp, Nextel 0010026. A copy of the CD is provided on the following page for reference.

Applicant: Motorola, Inc
Mark:(SENSORY MARK ONLY)

Nextel - 0010026
Opp. No. 91/161,817

USPTO
CD, COPY
911 Hz chirp

Date: 04/14/04

Disc 1 of 1

Document ID =78/235618
Docket No: TM03-1006
CLASS: 9

EXHIBIT 8

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 8 in Support of Applicant's Motion for Summary Judgment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Nextel Communications, Inc.,)	
)	
Opposer,)	
)	Opposition No. 91161817
v.)	
)	
Motorola, Inc.,)	App. No. 78/235,618
)	
Applicant.)	SENSORY MARK (911 Hz Tone)

**APPLICANT'S FIRST NOTICE OF DEPOSITION
OF OPPOSER PURSUANT TO FED.R.CIV.P. 30(B)(6)**

Please take notice that on March 14, 2005, beginning at 9:00 a.m. at the offices of Brinks Hofer Gilson & Lione, 455 North Cityfront Plaza Drive, Suite 3600, Chicago, IL 60611, or at another location that is mutually agreeable to the parties, and continuing thereafter from day to day until completed, Applicant will take the deposition of Opposer pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure on each Deposition Category listed below. The deposition will be transcribed by videotape and/or certified short-hand reporter.

Opposer is requested to designate to Applicant's counsel, on or before March 7, 2005, the person(s) whom Opposer is designating in response to each Deposition Category.

For purposes of this Notice, "Applicant's Mark" means the mark that is the subject of Application No. 78/235,618.

DEPOSITION CATEGORIES

1. The facts on which Opposer bases its contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (§ 9 of Notice of Opposition).



2. The facts on which Opposer bases its contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (§ 10 of Notice of Opposition).

3. The facts on which Opposer bases its contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (§ 10 of Notice of Opposition).

4. The facts in which Opposer bases its contention that it will be damaged if Applicant's Mark is registered (§ 11 of Notice of Opposition).

5. The types of individuals and the classes of consumers or entities who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

6. Every opinion that Opposer has received, from legal counsel or otherwise, relating to Applicant's Mark, including but not limited to any opinion on whether Applicant has used the Mark, whether the Mark is inherently distinctive, or whether the Mark has acquired distinctiveness.

7. How and to whom Opposer's and Applicant's two-way radios are marketed, promoted, sold, and distributed.

8. Opposer's first knowledge of Applicant's Mark, of Applicant's use of the Mark in connection with two-way radios, and of Application No. 78/235,618.

9. Any instance in which a person has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

10. The types of individuals or entities, or the classes of consumers or entities, who purchase or use two-way radios that emit Applicant's Mark or any mark similar thereto.

11. Opposer's yearly sales volume (in units, dollars, and number of purchasers) of two-way radios.

12. Each entity from whom Opposer purchases or has purchased two-way radios.

13. Advertisements or promotional items that includes Applicant's Mark, including any such advertisements or promotional items that are used by, on behalf of, or for the benefit of Opposer, and the yearly amount spent for each advertisement or promotional item.

14. Opposer's use of Applicant's Mark in Opposer's advertisements or promotional items.

15. The development or drafting of advertisements or promotional items that use Applicant's Mark, whether the advertisement or promotional item was ever distributed, displayed, or used.

16. Trademark searches conducted by or on behalf of Opposer for or in connection with Applicant's Mark.

17. Surveys, polls, research, or investigations made conducted by, on behalf of, or for the benefit of Opposer that refer or relate to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.

18. Any instance in which an individual has been, or may have been, confused as to the source of Applicant's two-way radios or for any service provided by Applicant in connection with such radios.

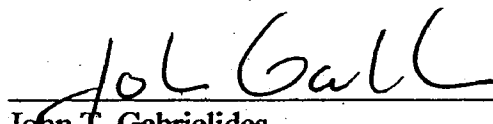
19. The manner in which Opposer markets, promotes, sells, or distributes two-way radios.

20. Opposer's policies and procedures regarding the destruction or retention of documents.

21. Prior and current third-party uses of Applicant's Mark or any mark similar thereto.

Motorola, Inc.

By:



John T. Gabrielides
Elisa M. Valenzona
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(312) 321 4200
(312) 321 4299 (fax)

Attorneys for Applicant

Certificate of Service

I hereby certify that a true copy of APPLICANT'S FIRST NOTICE OF DEPOSITION OF OPPOSER PURSUANT TO FED.R.CIV.P. 30(B)(6) was served on Opposer's counsel on March 1, 2005, by sending the document via first class mail, postage prepaid, to:

Michael H. Jacobs
Crowell & Moring LLP
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004

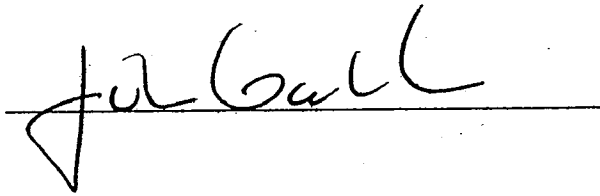
A handwritten signature, appearing to read "J. A. Gull", is written over a horizontal line.

EXHIBIT 9

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 9 in Support of Applicant's Motion for Summary Judgment

EXHIBIT 3

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 3 in Support of Applicant's Motion for Summary Judgment